The Office Action has been carefully considered. In the Office Action, Claims 24 and 32 are indicated as being allowable if written in independent form. Claims 1-3, 5-23 and 25-31 were rejected in the following manner.

1. Claims 1, 8, 11 and 19 were rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention.

2. Claims 1-3, 5-11 and 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Safadi's US Patent No. 2003/0126086 (hereinafter "*Safadi*") in view of Lisanke's US Patent No. 2004/0230806 (hereinafter "*Lisanke*").

3. Claims 12-14 and 21-23 and 25-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Safadi* in view of *Lisanke* and further in view of Suzuki et al's US Patent No. 6,463,445 (hereinafter "*Suzuki*").

Allowances

Claims 24 and 32 are objected to as being dependent upon a rejected base claim, but are indicated as being allowable if written in independent form. Additionally, the Office Action indicates that Claims 33 and 34 are allowable.

35 U.S.C. § 101 Rejections

Claims 1, 8, 11 and 19 were rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of invention. Claims 1, 8, 11 and 19 as currently amended fall under one of the four statutory categories of invention, and are therefore in condition for allowance.

35 U.S.C. § 103(a) Rejections

Claims 1-3, 5-23, and 25-31 were rejected under 35 U.S.C. § 103 as being unpatentable over various combinations of *Safadi*, *Lisanke*, and *Suzuki*. Applicants respectfully traverse the rejections of Claims 1-3, 5-23, and 25-31 and Applicants respectfully submit that the Office Action fails to state a *prima facie* case under § 103 and that Claims 1-3, 5-23, and 25-31 are in condition for allowance.

Claims 1, 8, 11 and 19 include elements not taught by the references

Claims 1, 8, 11 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Safadi* in view of *Lisanke*. To establish a *prima facie* case of obviousness, an Office Action must demonstrate that all claimed elements are taught or suggested by proffered references. Section

2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of cited references must also teach or suggest *each and every claim feature*. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the references).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). For example, in *In re Wada and Murphy,* Appeal 2007-3733, the BPAI specifically states that:

> "When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the references." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added))."

In sum, it remains well-settled law that obviousness requires **at least a suggestion of all of the elements of a claim**. *See In re Wada and Murphy, citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

The Claims 1, 8, 11 and 19 include elements that are not taught or suggested by the references cited in the Office Action. Specifically, *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest (1) receiving a selection of dynamically installable modules; and (2) a compression or decompression module as recited in independent Claims 1, 8, 11 and 19.

For example, amended Claim 1 reads:

A computer implemented method of delivering digital media, the method comprising:
a computer receiving digital media from a first device;
the computer receiving a selection of a plurality of **dynamically installable transcoding modules, including a file format module and at least one of a compression module and an encryption modul**e;
the computer dynamically installing the selected plurality of dynamically installable transcoding modules;

> the computer transforming the digital media in accordance with the selected transcoding modules; and
>
> the computer delivering the transformed digital media to a second device.

Accordingly, Claim 1 relates to selection of dynamically installable transcoding modules and their dynamic installation. Specific modules recited by Claim 1 include a file format module, a compression module, and an encryption module.

In contrast, *Safadi* is directed towards a processor "provided for converting the original DRM scheme to a native DRM scheme which is compatible with a consumer device used to process the content. Additionally, *Lisanke* is directed to "an efficient and easy-to-implement method to use existing DRM (Digital Rights Management) systems with existing media players… [which] separates the enforcement of digital rights independent of the content rendering software."

Again, Claims 1, 8, 11 and 19 include elements that are not taught or suggested by the references cited in the Office Action, which is discussed in further detail below. Specifically, *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest (1) receiving a selection of dynamically installable modules; and (2) a compression or decompression module as recited in independent Claims 1, 8, 11 and 19.

Safadi in view of *Lisanke* fails to teach or suggest dynamically installable modules as recited in independent Claims 1, 8, 11 and 19.

The Office Action acknowledges that *Safadi* fails to teach or suggest dynamically installing transcoding modules. Applicants agree. However, Applicants submit that *Lisanke* fails to remedy this teaching deficiency of *Safadi*.

The Office Action, at 4, cites ¶[0013], lines 1-5 and ¶[0012], lines 5-9 of *Lisanke* as teaching or suggesting dynamically installable **transcoding modules**. However, Applicants respectfully submit that these sections, when read in light of *Lisanke* as a whole, teach or suggest only **dynamic instrumentation**, and not dynamically installable **transcoding modules**.

While *Lisanke* uses the term "dynamically installable" when introducing its technology, the term is not applied to **transcoding modules**. Specifically, *Lisanke* states: "The present invention provides a mechanism to dynamically install and control the operation of all applications handling DRM content, and those applications which may attempt to access this content **via inter-process OS mechanisms**." ¶[0013], lines 1-5. However, the remainder of *Lisanke* fails to teach or suggest that other elements are dynamically installable and therefore

Ayars, Jeffrey M. – DIGITAL RIGHTS   14   Attorney Docket No. REAL-2007109
MANAGEMENT HANDLER AND   (RN126)
RELATED METHODS

refers strictly to the inter-process OS mechanism. The remainder of *Lisanke* refers only to **dynamic instrumentation** ("DI").

Accordingly, Applicants submit that *Lisanke* and *Safadi*, either alone or in combination, fail teach or suggest dynamically installable transcoding modules. Instead, *Lisanke* is directed merely to dynamic instrumentation (i.e., code injection). For example, *Lisanke* recites a definition of dynamic instrumentation at ¶ [0036]:

> The term "dynamic instrumentation" refers to technique; typically to **splicing dynamically code sequences into specific points** of an operating system kernel or application code without the need to alter the source code of the operating system kernel or application code being instrumented [by] overwrit[ing] the machine code instructions at an instrumentation point with a jump to the patch code.

In contrast to the dynamically installed transcoding modules as in Claim 1, *Lisanke's* system for handling a particular DRM scheme is **already installed**. *Lisanke* simply attempts to inject a DRM conversion scheme from an application that has already been installed via dynamic instrumentation (i.e., code injection) into an existing media player. *See, e.g.,* ¶¶ [0007]-[0011].

For example, *Lisanke* states "a need exists for a method and system to allow providers of DRM systems to protect digital content without the need to install specific DRM client players and plug-ins to render the digital content." However, to solve the problem, *Lisanke* merely proposes the installation of a helper program for a given DRM scheme to accompany an existing media player. Accordingly, *Lisanke* benefits a user by preventing them from having to install a new player for a new DRM scheme; however, *Lisanke* (alone or in combination with *Safadi*) does not teach or suggest dynamically installing the transcoding modules needed for a new DRM scheme. Instead, Applicants respectfully submit that a user of the *Lisanke* system would need to install a new helper application.

For at least the foregoing reason, Applicants respectfully submit that *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest all the elements of Claim 1. Claims 8, 11 and 19 recite similar elements and are therefore allowable for at least similar reasons. Accordingly, Claims 1, 8, 11 and 19 are in condition for allowance along with any claims depending therefrom.

Safadi and *Lisanke* fail to teach or suggest receiving a selection of dynamically installable modules as recited in independent Claims 1, 8, 11 and 19.

In addition to failing to teach dynamically installing transcoding modules generally, Applicants respectfully submit *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest receiving a **selection** of dynamically installable **modules** as recited Claims 1, 8, 11 and 19.

The Office Action asserts that *Safadi* teaches that 'a file format module' must thus be included to achieve the converting function in the DRM system." However, Applicants respectfully submit that *Safadi* fails to teach or suggest separate, dynamically installable modules (i.e., file format modules, compression modules, and encryption modules) and *Lisanke* does not remedy teaching deficiency, as discussed above.

In contrast to the flexible, modular features recited by Claim 1, *Safadi* discloses only a singular system designed to convert an "original DRM scheme to a native DRM scheme" on a singular "processor" ¶ [0028]. Thus, a **singular** DRM scheme needs to be installed under *Safadi* in contrast to a selection of a **plurality** of modules as recited by Claim 1.

Similarly, as discussed above, each of *Lisanke's* helper applications would have to be installed separately and, presumably, all the DRM technologies would already be embedded within that helper application. Put simply, *Lisanke* is silent on a method of dynamically installing transcoding modules such as file format modules, compression modules, and encryption modules. By contrast, Claim 1 recites receiving a **selection of dynamically installable modules**. *Safadi* and *Lisanke* fail to teach or suggest the modular approach recited by Claim 1.

For at least these additional foregoing reasons, Applicants respectfully submit that *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest the elements of Claim 1 and thus fail to establish a *prima facie* case of obviousness under § 103. Claim 1, is therefore in condition for allowance. Claims 8, 11 and 19 recite similar elements and are therefore allowable for at least similar reasons. Accordingly, Claims 1, 8, 11 and 19 are in condition for allowance along with any claims depending therefrom.

<u>*Safadi* and *Lisanke* fail to teach or suggest a compression or decompression module as in Claims 1, 8, 11 and 19.</u>

The Office Action, at 8, acknowledges that the combination of *Safadi* and *Lisanke* fail to teach or suggest a compression or decompression technique. Applicants agree. However, the Office Action fails to provide any rationale as to why *Safadi* and *Lisanke,* either alone or in combination, teaches or suggests a compression or decompression technique. Accordingly, Applicants respectfully submit that the Office Action therefore fails to establish a *prima facie* case of obviousness under § 103, and that Claims 1, 8, 11, and 19 are in condition for allowance.

Claims 2-3, 5-7, 9-10, 15-18 and 20

Additionally, the Office Action rejects Claims 2-3, 5-7, 9-10, 15-18 and 20 by asserting that *Safadi* and *Lisanke* teach or suggest the elements of Claims 2-3, 5-7, 9-10, 15-18 and 20. Applicants respectfully submit that Claims 2-3, 5-7, 9-10, 15-18 and 20 depend from allowable Claims 1, 8, 11, and 19 and that Claims 2-3, 5-7, 9-10, 15-18 and 20 are therefore allowable at least by dependency.

Furthermore, Applicants respectfully submit that the Office Action does not state a *prima facie* case under 35 U.S.C. § 103 because Claims 2-3, 5-7, 9-10, 15-18 and 20 recite elements not taught or suggested by *Safadi* and *Lisanke,* either alone or in combination.

For example, Claims 2-3, 5-7, 9-10, 15-18 and 20 recite features related to transcoding modules. As argued at length above, *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest the transcoding modules of Claims 2-3, 5-7, 9-10, 15-18 and 20 and thus fail to support a *prima facie* case of unpatentability under § 103.

In another example, Claims 5-7 recite features directed to the ability of consumers, operators, or driver modules to **select** the plurality of transcoding modules. Again, as argued at length above, *Safadi* and *Lisanke*, either alone or in combination, fail to teach or suggest the transcoding modules Claims 5-7 and therefore fail to support a *prima facie* case of obviousness under § 103. Accordingly, Applicants assert that Claims 2-3, 5-7, 9-10, 15-18 and 20 are in condition for allowance.

Claims 12-14, 21-23 and 25-31

Claims 12-14, 21-23 and 25-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Safadi* in view of *Lisanke* and further in view of *Suzuki*. However, Applicants respectfully submit that *Safadi*, *Lisanke* and *Suzuki*, either alone or in combination, fail to teach or suggest all elements of Claims 12-14, 21-23 and 25-31.

For example, Claim 23 recites as follows:

A system for protecting digital presentations via a digital rights management system, the system comprising:
a module configured to interact via a first storage device storing an input data file;
a module configured to interact via a second storage device;
a translation driver;
a digital rights management dynamically installable transcoding module encryption library, accessible by the translation driver, the encryption library comprising a plurality of modules, each module configured to encrypt data according to a particular digital rights management technique;
a file format type dynamically installable transcoding module library, accessible by the translation driver, the file format type transcoding module library comprising a plurality of modules, each module configured to read data using a different file format type;
a file writer dynamically installable transcoding module library, accessible by the translation driver, the file writer transcoding module library comprising a plurality of modules, each module configured to write to a different file format type;
a dynamically installable transcoding software module configured to:
determine a first file format type of the input file;
obtain input data from the input file using a file format class corresponding to the first file format;
select a first digital rights management encrypting module from the plurality comprising the digital rights management transcoding modules library;
encrypt the input data according to the first digital rights management system encrypting class;
determine a second file format type for a data output file; and
write the data output file containing the newly-encrypted data to the second storage device using a file writer module corresponding to the second file format type; and
dynamically installing the selection of a plurality of dynamically installable transcoding modules.

Applicants respectfully submit that *Suzuki* stands in contrast to the features recited in independent Claim 23 because it is generally directed at "a format converter that is able to automatically convert (transcode) encoded bitstream information from one format to another so that the client (receiver) is able to display the received information." Col. 3, lines 30-34.

Claims 23 and 27.

In a further example, elements of Claims 23 and 27 are not taught or suggested by *Safadi*, *Lisanke* and *Suzuki*, either alone or in combination. Specifically, *Safadi*, *Lisanke* and *Suzuki*, either alone or in combination, fail to teach (1) a selection of dynamically installable transcoding modules; and (2) a transcoding module library.

First, as asserted at length above, *Safadi*, *Lisanke*, and *Suzuki*, either alone or in combination, fail to teach or suggest a selection of dynamically installable transcoding modules as recited in independent Claims 23 and 27. Applicants respectfully note that the Office Action fails to assert that *Suzuki* remedies this defect in the combination of *Safadi* and *Lisanke*. Thus, Applicants respectfully assert that for at least this reason, the cited combination fails to support a *prima facie* case of obviousness under § 103.

Second, the Office Action, at 8, acknowledges that the combination of *Safadi* and *Lisanke* was silent on a transcoding module library. Applicants agree. However, Applicants respectfully disagree that *Suzuki* remedies the defect.

Applicants have reviewed the "transcoding tool library" disclosed in *Suzuki* and respectfully disagree with the interpretation asserted by the Office Action. Unlike the dynamically installable module library recited in Claim 23, *Suzuki's* tool library appears to merely be a static library of tools. For example, the *Suzuki* discloses the following: "At step 540, the transcoding device 350 requests and receives appropriate transcoding tools from a transcoding tool library 360 and performs a transcoding process of the MM Contents into a Transcoded Bitstream. If decoding is not required, then the MM contents 246b can be directly transcoded . . ." Col. 12, lines 55-67. Accordingly, *Suzuki* is silent on the dynamic nature of the elements of Claim 23. Additionally, Applicants have reviewed *Suzuki* in detail and fail to find another portion that would remedy such a teaching deficiency. *Safadi* and *Lisanke*, either alone or in combination, likewise fail to remedy such a teaching deficiency.

For at least the foregoing reasons, Applicants respectfully submit that the Office Action has failed to state a *prima facie* case of obviousness under § 103 with regards to Claim 23 and to Claim 27, which recites similar elements.

Accordingly, Applicants assert that all elements of Claims 12-14, 21-23 and 25-31 are not taught or suggested by *Safadi*, *Lisanke* and *Suzuki*, either alone or in combination, and that Claims 12-14, 21-23 and 25-31 are therefore in condition for allowance.

<u>CONCLUSION</u>

For at least the reasons above, Applicants respectfully submit that all pending claims are allowable and request that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the arguments presented are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments, and it is therefore not believed necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,

AXIOS LAW GROUP

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